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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,897	08/07/2000	William A. Royall, Jr.	ROY B-747	3640

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/633,897

Applicant(s)

ROYALL, JR. ET AL.

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/3/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-9 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Noel-Levitz (www.noellevitz.com, Newsletter archive, “Grading and qualifying prospects,” Winter 1998 (part 1) and Spring 1998 (part 2)).**
3. As per **independent Claims 1, 6, and 9**, Noel-Levitz discloses a method for profiling an inquiry pool of candidates interested (evaluating the continued interest of candidates) in attending an identified institution of higher learning preliminarily to providing candidates from the pool with an application for enrollment (direct mail), the method comprising the steps of: (a) providing a data base including information related to candidates for enrollment at an identified institution and the preferences of the identified institution for students with predetermined characteristics; (b) electronically evaluating the candidates in the database against a first predetermined profile including (grading and qualifying): (i) information as to the candidate’s high school class year (academic profile data), a prior visit of the candidate to the institution (campus visit status), and a source of the information about the candidate’s initial contact with the institution

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in the database (first contact source), and (ii) the preference of the institution, to thereby select candidates for further contact; and (c) providing a report of the electronic evaluation (www.noellewitz.com, Newsletter archive, "Grading and qualifying prospects," Winter 1998 (part 1) and Spring 1998 (part 2), pgs. 4-6 and 16-20).

4. As per Claim 2, Noel-Levitz discloses wherein the first predetermined profile includes the gender and ethnicity (race) of each candidate; and wherein the report of the electronic reevaluation includes an evaluation of the degree of gender and ethnicity representation of the candidates in the database.
5. As per Claim 3, Noel-Levitz discloses wherein the first predetermined profile also includes the geographic area residence of each candidate; and wherein the report of the electronic reevaluation also includes an evaluation of the degree of geographic area of residence representation of candidates in the database.
6. As per Claims 4 and 7, Noel-Levitz discloses (d) preparing a mailing list as a function of evaluated interest.
7. As per Claims 5 and 8, Noel-Levitz discloses wherein the data base includes a list of available documentation about the institution (relating to preselected features of the institution); and including the further steps of: (g) selecting documentation for mailing as a function of the profiling; and (h) mailing the selected documentation.
8. As per Claim 11, Noel-Levitz discloses (g) preparing a mailing list of selected candidates as a function of the evaluated continued interest.

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9. As per Claim 12, Noel-Levitz discloses wherein the data base includes a list of available documentation relating to preselected features of the institution; and including the further steps of: (h) selecting available documentation as a function of the electronic responses to the electronic request for information, and (i) mailing the selected documentation to each of the selected candidates on the mailing list.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The rejection of Claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Grady et al. is withdrawn due to applicant's arguments.

12. **Claims 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noel-Levitz.**

13. As per Claim 10, Noel-Levitz fails to expressly disclose wherein the electronic request includes the steps of: constructing an electronic survey; locating the electronic survey on a web page at the web site of the institution; create a unique access number for each candidate; providing each candidate with his unique access number in an e-mail request for information by an electronic survey; and

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automatically updating the data base with the responses from the electronic survey.

14. However, Noel-Levitz does disclose continually updating the prospective interest profile with each contact (pgs.4-5), and official notice is given that electronic mail and website surveys were well known methods of customer contact at the time the invention was made.
15. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the electronic request includes the steps of: constructing an electronic survey; locating the electronic survey on a web page at the web site of the institution; create a unique access number for each candidate; providing each candidate with his unique access number in an e-mail request for information by an electronic survey; and automatically updating the data base with the responses from the electronic survey in the system disclosed by Noel-Levitz, for the advantage of providing a method for profiling an inquiry pool of candidates interested in attending an identified institution of higher learning preliminarily to targeting candidates from the pool with for enrollment, with the ability to increase system effectiveness by automating the process of collecting prospect contact/update information.
16. As per amended **independent Claim 13**, Noel-Levitz discloses a method for evaluating the continued interest (interest throughout recruitment process) of candidates in attending an identified institution of higher learning preliminarily to providing the candidates with an application for enrollment (direct mail), the method comprising the steps of: (a) providing a data base including information

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related to candidates interested in enrollment at the identified institution and the preferences of the institution for students with predetermined characteristics; and (b) electronically evaluating the candidates in the database against a first predetermined profile (grading and qualifying); (e) electronically evaluating the selected candidates in the data base against a second predetermined profile to thereby gauge the continued interest of the selected candidates in attending the institutions (continually grading and qualifying through recruiting process); and (f) providing a report of the electronic reevaluation (www.noellevitz.com, Newsletter archive, "Grading and qualifying prospects," Winter 1998 (part 1) and Spring 1998 (part 2), pgs. 4-6 and 16-20).

17. Noel-Levitz fails to expressly disclose (c) providing a web page for the institution, the web page housing a survey requesting predetermined information related to the continued interest of candidates in enrolling at the institution; (d) sending an e-mail to the selected candidates directing them to the institutions web page.
18. However, Noel-Levitz does disclose continually updating the prospective interest profile with each contact (pgs.4-5), and official notice is given that electronic mail and website surveys were well known methods of customer contact at the time the invention was made.
19. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included providing a web page for the institution, the web page housing a survey requesting predetermined information related to the continued interest of candidates in enrolling at the institution, and

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sending an e-mail to the selected candidates directing them to the institutions web page in the system disclosed by Noel-Levitz, for the advantage of providing a method for profiling an inquiry pool of candidates interested in attending an identified institution of higher learning preliminarily to targeting candidates from the pool with for enrollment, with the ability to increase system effectiveness by automating the process of collecting prospect contact/update information.

20. As per Claim 14, Noel-Levitz disclose wherein selected candidates are directed to the web page by a hyperlink, which uniquely identifies the candidates to whom the e-mail is sent so that the survey includes information relating to the candidates when it initially appears.

Response to Arguments

21. Applicant's arguments with respect to Claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.
22. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:
- (c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (*e.g.*, additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment

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document will serve to replace all prior versions of the claims, in the application.

In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression:

(Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (*e.g.*, Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or

“withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

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(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

23. Applicant's previous amendment (filed 9/15/2003) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

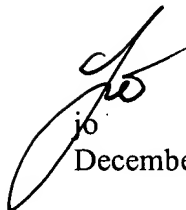
Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

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26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

A handwritten signature in black ink, appearing to be 'Jo', written over the date.

December 23, 2004

A handwritten signature in black ink, appearing to be 'Dennis Ruhl', written above the printed name.

DENNIS RUHL
PRIMARY EXAMINER